

DOCKET NO. TOS-157-USA-PCT

REMARKS

The Examiner is thanked for the very thorough and professional office action, and especially for providing a detailed response to the arguments in the previous amendment. Pursuant to that office action, Claims 3, 5 and 7 have been cancelled, and Claim 1 rewritten to more definitely set forth the invention and obviate the rejections. Support for the amendment of Claim 1 can be found in original Claim 3 and in the specification on pages 24-28 and in Tables 1-3. The proposed amendment is deemed not to include new matter. Claims 1, 2, 4 and 6 remain in the application.

Reconsideration is respectfully requested of the rejection of Claims 1-7 provisionally on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1, 5, 7, 11 and 16 of copending application No. 09/936,317 in view of machine translation of unexamined patent application by Sato, et al.

Application Serial No. 09/936,317 is now abandoned, and it is therefore believed that this double patenting rejection fails. However, a continuation was recently filed of copending application 09/936,317, containing new claims. These new claims call for a process of making a microgel and for compositions containing a microgel made by that process.

The new continuation application does not contain claims directed to a water-in-oil emulsion as now called for in the claims herein. The water-in-oil emulsion of the present invention concerns a composition that exhibits good emulsified states, does not change over different temperature and/or time, has superior stability, and gives a non-sticky, fresh, and good

DOCKET NO. TOS-157-USA-PCT

tactile sensation during use.

It is respectfully submitted that the claims of the present invention are neither anticipated by nor obvious over the new continuation application in view of Sato, et al., because they concern different subject matter, and the composition in the present application is nowhere disclosed in either Sato, et al. or the new continuation application. It is therefore respectfully urged that the claims of the present invention are patentably distinct from the subject matter in the new continuation application in view of Sato, et al. Consequently, the rejection fails for the reason set forth above. Withdrawal of the double patenting rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Delrieu, et al. in view of Sato, et al.

The Examiner's primary reference of Delrieu, et al. is concerned with a cosmetic or dermatological delivery system of a gel delivery system for a topically applied active agent. In particular, the delivery system of Delrieu, et al. is comprised of discreet gel particles formed of:

“a) an agar gel; and

b) a restraining polymer dispersed in the agar gel, the restraining polymer having sufficient molecular weight to prevent egress of the restraining polymer from the agar gel, and having retention groups to bind the active agent to the restraining polymer for retention in the gel particles and being present in a proportion sufficient to deliver an effective amount of the active agent; ---“

DOCKET NO. TOS-157-USA-PCT

It is apparent from the quoted passage of Delrieu, et al. in column 4, lines 6-20, that a restraining polymer and an active agent are present in the agar gel forming the microgel. However, Claim 1 as amended is believed to exclude any component in the microgel other than water, aqueous component, and hydrophobic compounds identified in the claim.

The gel particles of Delrieu, et al. are manually crushable on the skin to increase the surface area of the gel particle material, and to expose the restraining polymer to the skin or other body surface for release of the active agent. (see Delrieu, et al., column 4, lines 6-20) This delivery system can be applied in either an oil-in-water or water-in-oil emulsion.

The Examiner has recognized that the primary reference of Delrieu, et al. "does not explicitly teach cosmetic compositions where the other ingredients are specifically disclosed, or the specific percentages for the components". Therefore, it is respectfully submitted that the primary reference of Delrieu, et al. fails to disclose the water-in-oil emulsion now called for in the claims herein, especially the particular components including the microgel, and the percentages of each of these components in the water-in-oil composition.

To cure the deficiencies of Delrieu, et al., the Examiner relies upon the secondary reference of Sato, et al. to supply details concerning the water-in-oil emulsion. In particular, the Examiner relies upon Sato, et al. to show a water-in-oil emulsion containing an organophilic clay mineral and an emulsifier having an HLB value of seven or less in the oil phase. However, Sato, et al. fail to cure the deficiencies of the primary reference of Delrieu, et al., since there is no disclosure in the secondary reference of a water-in-oil emulsion containing a microgel as now

DOCKET NO. TOS-157-USA-PCT

called for in the claim herein.

Moreover, it is respectfully urged that there is no teaching, suggestion, or motivation in either of the references relied upon to combine them in the manner suggested by the Examiner. Further, it is unclear from the rejection whether the Examiner considers the polymer containing agar gel particles of Delrieu, et al. to function in the same way to achieve the same result as the microgel particles now called for in Claim 1 herein. As pointed out above, the agar gel of Delrieu, et al. contains a restraining polymer and active agent dispersed in the agar gel which clearly differs from the microgel now called for in the claim herein. In view of these fundamental differences, and the lack of any disclosure in the Examiner's primary reference of Delrieu, et al. of the components forming the claimed water-in-oil emulsion of the present invention, it is respectfully submitted that the Examiner's combination of references fail to teach or suggest the water-in-oil emulsion now called for in the claims herein.

The problem solved by the present invention is to produce a water-in-oil emulsion having a satisfactory sensation during use, such as smoothness, moistening sensation, and non-stickiness, as well as satisfactory emulsion properties, such as long term stability, and stability over high and low temperature ranges. The present inventors conducted numerous test examples of the present invention, as well as comparative tests of similar compositions that do not have all of the components called for in the claims herein. These numerous test results are set forth in Table 1 on page 25, Table 2 on page 26, and Table 3 on page 28.

There it can be seen that some compositions containing the claimed organophilic clay mineral may produce a stable emulsion but fail to provide satisfactory properties of non-

DOCKET NO. TOS-157-USA-PCT

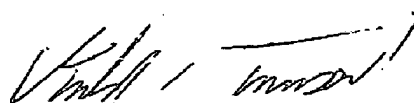
stickiness, smoothness, or moistening sensation.

It is respectfully urged that the reasons for the Examiners combining of references fails to take into account the problems confronted by the inventors and the unexpected results discovered in the numerous tests set forth in the specification. Consequently, it is believed that the reasons for combining these references fails to meet the legal standards set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. (1966). For these reasons, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

TOWNSEND & BANTA



Donald E. Townsend
Reg. No. 22,069

Date: May 22, 2008

Customer No. 27955

RECEIVED
CENTRAL FAX CENTER

From: D Townsend Jr

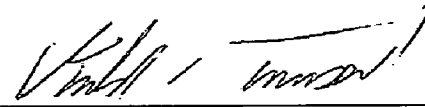
MAY 22 2008

DOCKET NO. TOS-157-USA-PCT

TOWNSEND & BANTA
c/o FoundationIP
P.O. Box 52050
Minneapolis, MN 55402
(202) 220-3124

CERTIFICATE OF TRANSMISSION

I hereby certify that this facsimile transmission, consisting of a 9-page Amendment, as well as 1-page Transmittal, in U.S. patent application serial No. 10/501,462, filed on December 13, 2004, is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax no. 571-273-8300) on May 22, 2008.



Donald E. Townsend